



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/088,885	03/22/2002	Thomas Fahrig	Le A 33 914	5212

7590 02/25/2004

Jeffrey M Greenman
Vice President, Patents and Licensing
Bayer Corporation
400 Morgan Lane
West Haven, CT 06516

EXAMINER

FORD, JOHN M

ART UNIT	PAPER NUMBER
----------	--------------

1624

DATE MAILED: 02/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/088,885

Applicant(s)

Fahrig et al

Examiner

J.M. Ford

Group Art Unit

1624

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE THREE MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- ☒ Responsive to communication(s) filed on January 5, 2004
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1 - A is/are pending in the application.
- Of the above claim(s) 3 is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1, 2 and 4 - A is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement

Application Papers

- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).
- ☐ All ☐ Some* ☐ None of the:
- ☐ Certified copies of the priority documents have been received.
- ☐ Certified copies of the priority documents have been received in Application No. _____.
- ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a))

*Certified copies not received: _____

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Interview Summary, PTO-413
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other _____

Office Action Summary

Art Unit: 1624

Applicants' response of January 5, 2004, is noted.

The claims in the application are claims 1—8.

The main rejection, that prevents allowance, here, is claim 7.

The method of making a composition is well known. See the art of record. Claim 7 could not be allowed, here.

This is a 371 application. Content in a 371 application is governed by 37 CFR1. 475.

37 CFR1. 475 provides for one product, and method of use in a 371 application.

The treatment of multiple Sclerosis is applicants' method of use. It would not be within Rule 475 to also include the unpatentable method of using the compounds in claim 7.

Multiple Sclerosis is a very sensitive area of utility. The USPTO is permitted to request proof of utility in a sensitive area of utility that does not have an established successful method of treatment.

Prevention would require much more proof than treating. Therefore, "a prophylaxis" need be removed from line 1 of claim 1.

Claim 1 is not one product as required by 37 CFR 1.475. Claim 1 is unsearchable as it includes too many heterocyclic products in (T) x-A, for instance.

Applicants elected a dihydro isoindole.

The only dihydro isoindole is not in (T) x A at all, but in R7, second formula of page 9 of the most recent amendment.

Therefore, X is zero in the elected material and T is not present.

Art Unit: 1624

Claim 1 is too big to be searched.

What we need here is a genus from the elected subject matter.

Claim 1 should be re-written to the elected subject matter.

37 CFR 1.475 provides for one product, not multiple products.

The multiple heterocyclic rings of pages 4, 7 and 9 of claim 1 are overwhelming.

Claim 1 is rejected as not complying with 35 USC 112, 1st or 2nd paragraph or 35 USC 101, or 37 CFR 1.475. Claim 1 is rejected as being an improper joinder of multiple independent inventions that will support separate patents depending on the heterocyclic ring.

Consider claim 2. The elected R7 is the first instance. The 1, 2nd and 4th instances of that R7 could be reasonably considered here.

In re Joyce, 115 USPQ 42 and In re Herrick provide that an election of species is tantamount to a restriction requirement.

Divisional applications filed, thereafter, are not subject to a double patenting ground of rejection; 35 USC 121.

It is not known what claim 3 is doing here or what it has to do with the rest of the application. Claim 3 is held withdrawn as not relating to the real world of Commerce, see the last office action in regard to Brenner vs Manson.

Claim 4 is rejected only as being dependent on a rejected claim.

Claim 5 has the last two species that are outside the invention elected here.

Any claim not rejected or withdrawn is rejected as being dependent on a rejected claim.

Art Unit: 1624

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John M Ford whose telephone number is 703-308-4721. The examiner can normally be reached on Tuesday-Thursday 9 am - 3 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mukund Shah can be reached on 703-308-4716. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Ford/tgd

February 3, 2004


RICHARD L. RAYMOND
ACTING SPE
ART UNIT 1624